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EXAMINER				
FISHER, MICHAEL J				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/619,542

Applicant(s)

BAYER ET AL.

Examiner

MICHAEL J. FISHER

Art Unit

3689

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-225 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-225 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SG/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Double Patenting

Claims 1-225 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims of U.S. Patent No. 7,113,853. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are both drawn toward checking the title history of a vehicle and are used to check previous owners, while the intended use is different, all the same information is collected and the uses for the collected information are deemed to be obvious variants. Allowance of a patent merely for intended use would unfairly and improperly extend the period.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-100,136-178,183-225 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As to claim 136-178, 183-186 and 195-198, the claims recite a computer readable medium without any computer apparatus, as such, they could merely be a signal. Further, they do not cause the computer to do anything, they merely include instructions that could merely be displayed to tell the user how to perform the task.

Claims 1-100, 187-194 and 199-225 are directed toward a computer implement method in which there is merely a trivial use of the computer. The computer merely sends,

receives, stores and displays information without any manipulation, all the "determining" could be done by a user merely looking at data on a screen.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-225 are rejected under 35 U.S.C. 103(a) as being unpatentable over US PAT 4,989,144 to Barnett, III (Barnett).

As to claims 1,61, 78,79,95,99,101,121,132,136,187,199, Barnett discloses identifying records in a database related to a vehicle (title), identifying ownership data (col 7, lines 6-10), identifying a target record that is a sale (col 7, lines 9-16). Barnett does not, however, teach using the data to adjust ownership. Barnett does discuss a

"salvage" title and further, it is old and well known in the art that a one-owner vehicle is more prized than one which has had multiple owners (for instance, ads that claim "Clean-one-owner!"). Therefore, it would have been obvious to one of ordinary skill in the art to use the method and system as taught by Barnett for adjusting the price of vehicles as a vehicle sold as "salvage" is worth much less than one without, a vehicle with "true mileage unknown" (which would be recorded at a sale) is also worth less and further, a one owner vehicle can be worth more if only by perception.

As to claim 175, it is done electronically (fig 1).

As to claim 102,122,134,186, there is a user interface with display (fig 1), it can be adapted to display any information contained within the system.

As to claim 135, the number of owners is counted (table III).

As to claims 10, the target records are flagged in case of transfer (new title).

As to claims 2,62,80, it is old and well known for used car lots to display the price of the vehicles they're selling, therefore, it would have been obvious to one of ordinary skill in the art to display the price and any mark-downs so a customer can see how much the vehicle costs.

As to claims 81, a dealer accesses the records (fig 1).

As to claims 3,103, 180,201, the record is vehicle title (col 7, table III-continued in lines 1-4).

As to claim 219, there is a dealer sale record (fig 7) that would be used to determine number of owners.

As to claim 217, the record is a user confirmation record (titling and/or registering a vehicle could be a "user confirmation record").

As to claims 4,104,202, the target record is flagged in case of ownership transfer (col 3, lines 51-57).

As to claims 5,12,63, 106,203, Barnett determines a time between records (table III, col 6).

As to claims 6,-9,13,64,105,204, it would be obvious to check the date as a flag as this could indicate an odometer change (for instance, a car is sold at a 10 year interval and only has 1,000 more miles or 100 miles/year). The interval is deemed a matter of obvious, engineering design choice and would not render the instant application patentably distinct.

As to claims 205, Barnett determines a time between records (table III, col 6).

As to claims 65, the regions are shown (table III).

As to claims 14,85, the target record is flagged in case of ownership transfer (col 3, lines 51-57).

As to claim 216, it would be obvious to use retrieval by a dealer as a trigger record to see if the dealer purchased the vehicle to ascertain number of owners.

As to claims 86, 206, target and trigger records are recorded with their time interval (table III).

As to claims 207,208, it would be obvious to check the date as a flag as this could indicate an odometer change (for instance, a car is sold at a 10 year interval and only has 1,000 more miles or 100 miles/year). The interval is deemed a matter of

obvious, engineering design choice and would not render the instant application patentably distinct.

As to claims 209, the record is vehicle title (col 7, table III-continued in lines 1-4).

As to claim 11, it would be obvious to one of ordinary skill in the art to use registrations as they also record sales and data about the vehicle.

As to claim 15,210, Barnett displays the flags (table IV).

As to claim 16,107, Barnett displays and counts ownership transfers (table III).

As to claim 17,191,200, it would be obvious to determine a price change in order to be able to decide on a selling price for the vehicle.

As to claim 18,181,185,189,193,196,197,as discussed, it is obvious to charge more for a one-owner vehicle, therefore, it would be obvious to charge less for a vehicle with more than one owner and more for one with more owners.

As to claim 19,108, the third party is the state.

As to claims 20,87-88,123, the interval is deemed a matter of obvious, engineering design choice and would not render the instant application patentably distinct. The examiner will note that the time difference mention is 60 days (col 8, lines 25-50).

As to claim 125, regions are shown (table III).

As to claim 89,98,211, the record indicates ownership transfers, it would be obvious to count them to determine if the number of transfers is "one" (i.e. only transferred to the dealer) or "none" (if the owner is selling the vehicle) to note that the vehicle is a one-owner vehicle.

As to claim 90,91,130, as discussed, it is obvious to charge more for a one-owner vehicle, therefore, it would be obvious to charge less for a vehicle with more than one owner.

As to claim 221, the regions are checked (fig 10).

As to claim 92,109,110,111, region information and sale information is recorded (table III).

As to claim 112, the system would show a first ownership (the first person to which the vehicle was titled).

As to claim 21, the organization is recorded (table III).

As to claims 22, these are well known organizations that sell cars and would not render the instant application patentably distinct.

As to claims 23, 113, the interval is deemed a matter of obvious, engineering design choice and would not render the instant application patentably distinct.

As to claims 24, a "salvage" would include a service plan record.

As to claims 25, the interval is deemed a matter of obvious, engineering design choice and would not render the instant application patentably distinct.

As to claims 26, the "dealer usage record" would be the sale.

As to claim 220, the database stores the vehicles' information.

As to claims 27, the interval is deemed a matter of obvious, engineering design choice and would not render the instant application patentably distinct.

As to claim 28, the signing of the title for sale is considered to be "a user confirmation".

As to claim 222, the change of owner's name would be used to determine if the ownership changed.

As to claim 29,82, the user "questionnaire" would be the request for the information.

As to claims 30, the interval is deemed a matter of obvious, engineering design choice and would not render the instant application patentably distinct.

As to claim 31, the record is a dealer record (table III).

As to claims 32, 83, it is old and well known to store information on a database, therefore, it would have been obvious to one of ordinary skill in the art to store data on a database to ensure it is saved.

As to claim 223, the time interval would not render the instant invention patentably distinct, there is a moving record, as previously discussed.

As to claims 84, it would be obvious to use a registration as these also record transaction information.

As to claim 218, the record is of sale (fig 7).

As to claims 33, the interval is deemed a matter of obvious, engineering design choice and would not render the instant application patentably distinct.

As to claim 34,35,94,97, there are regions determined (table III).

As to claim 224, the owner's name is shown, this would be used to determine if ownership changed, thereby meeting the limitations as claimed.

As to claims 36,66,93,96,125,133, it would be obvious to one of ordinary skill in the art to check a "moving (or mover) record" to ensure the vehicle was actually transferred to a different region ,as shown in table III.

As to claims 37, the interval is deemed a matter of obvious, engineering design choice and would not render the instant application patentably distinct.

As to claims 133, it would be obvious to one of ordinary skill in the art to check a "moving (or mover) record" to ensure the vehicle was actually transferred to a different region ,as shown in table III, the interval is deemed a matter of obvious, engineering design choice and would not render the instant application patentably distinct.

As to claim 38,67,126, there are regions determined (table III) and sales, thereby meeting the limitations as claimed.

As to claim 127, the first name would be the first owner.

As to claim 39, the advisory is in table III.

As to claim 40,68,115, it would be obvious to determine if the user was the first owner so as to know if it is a one-owner vehicle.

As to claim 225, it would be obvious to display that the owner moved but did not sell the vehicle to show that the vehicle is a one-owner vehicle even if the address changed.

As to claims 41-43, 69-71,128, the interval is deemed a matter of obvious, engineering design choice and would not render the instant application patentably distinct.

As to claim 218, the user "questionnaire" would be the request for the information.

As to claim 44,72,114, it would be obvious to use a predetermined mileage to determine if the owner was the first (for instance, less than 10 miles as a new car generally has very few miles on it), the exact mileage would be a matter of obvious, engineering design choice and would not render the instant invention patentably distinct.

As to claims 45,46,73,74, the interval is deemed a matter of obvious, engineering design choice and would not render the instant application patentably distinct.

As to claim 47,48,75,76, it would be obvious to determine and display if the user was the first owner so as to know if it is a one-owner vehicle.

As to claim 49,116, as discussed, it is obvious to charge more for a one-owner vehicle, therefore, it would be obvious to charge less for a vehicle where the number of owners is unknown and therefore, could not be promised as a "one-owner" vehicle.

As to claims 50, as discussed, it is obvious to charge more for a one-owner vehicle, therefore, it would be obvious to charge less for a vehicle with more than one owner.

As to claim 215, the record is a service plan record (fig 7).

As to claims 51 and 52,77,100,117, 118,,119,120,131,137,190,194,198, it is old and well known to decide vehicle costs based on make, model, year, published value, therefore, it would have been obvious to use these factors as otherwise, a 2002 Hyundai with 200,000 miles could have the same asking price as a 2008 Mercedes

convertible with 5,000 miles. Further, for claim 117 and 120,, Blue Books adjust prices based on actual sales, thereby meeting the limitations as claimed.

As to claim 213, the organization is an auction (fig 10).

As to claim 53, it is old and well known to base cost on age of vehicle, therefore, it would have been obvious to use these factors as otherwise, a 2008 Mercedes convertible with 200,000 miles could have the same asking price as a 2008 Mercedes convertible with 5,000 miles.

As to claim 212, third party is the state.

As to claim 54, it is obvious to use a well known item such as a "blue book" for its intended task.

As to claim 55, it is obvious to use the price range supplied from a "blue book" in setting prices, such as "clean price" or "high mileage price", et al.

As to claims 56,60, it is obvious to base a price on a category of the vehicle, for instance, when gas prices are high, vehicle with low gas mileage are cheaper while those with high gas mileage are more desirable and therefore, more expensive.

As to claims 57, it would be obvious to base price on ownership time and mileage patterns (for instance, a 40 year old car with 80,000 miles would be more desirable than a 40 year old car with 800,000 miles).

As to claim 214, the organization is an auction (fig 10).

As to claims 58, as discussed, it is obvious to charge more for a one-owner vehicle.

As to claims 59, the number of owners is displayed (table III).

Response to Arguments

Applicant's arguments filed 3/6/09 have been fully considered but they are not persuasive. As to arguments that the prior art does not teach "using the data to adjust ownership", the examiner disagrees. As the data saved includes changes of ownership, this would be "using the data to adjust ownership". It is old and well known for one-owner vehicles to be more valuable, therefore, using a known system for this use would be obvious. Merely changing the intended use of an invention would not render the invention patentably distinct. Were this so, someone could take the instant invention, were it allowed, and change it to look for "red cars" and receive a patent. This would be improper and shows that intended use does not render any invention patentably distinct unless the intended use itself were patentably distinct in some manner. As whether a vehicle is a one-owner vehicle is old and well known in the art to be a selling point, it would be obvious to use a known system to determine if the vehicle is a one-owner. As the prior art discloses tracking ownership changes, one would not only have a "reasonable expectation of success", it would be most unlikely that one would not find this information. Noting the name(s) of the owner(s) would be noting the numbers of vehicle owners.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL J. FISHER whose telephone number is

(571)272-6804. The examiner can normally be reached on Mon.-Fri. 7:30am-5:00pm
alt Fri. off.

The fax phone number for the organization where this application or proceeding
is assigned is 571-273-8300.

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/Michael J Fisher/
Examiner, Art Unit 3689
MF
5/25/09